

### **REMARKS**

Applicants wish to notify the Examiner that Applicants have requested a 3-month suspension of action under 37 C.F.R. §1.103(c).

New claim 37 has been added. Support for new claim 37 can be found in Figures 5A-5C and paragraph 47.

### **NEW MATTER**

The amendment file by Applicant was objected under 35 USC 132(a) for allegedly containing new matter. The changes which constituted new matter were: the changes to Figures 5a, 7 and 8b. Figure 5a was purported to define angle alpha as being measured between blade and angle theta1. Applicant respectfully disagrees.

Applicant submitted changes to Figures 5a to add in the skive angle  $\alpha$  for clarity. See also Applicants' definition of skive angle, paragraph 36. See also paragraph 42 that the skive angle is measured relative to plane of the strip. See also Fig. 9. Amended Fig. 5a correctly illustrates the skive angle as relative to the plane of the strip, and which is consistent with the specification. Thus, the addition of the skive angle in Fig 5a is not new matter. Applicant is simply conforming the drawings to the teachings of the specification.

With respect to Figure 8b, Applicant has amended Fig 8b to correct an erroneous and obvious error to the drawing. The Figure as amended now conforms to the specification as cited, above. Applicant has taught in the specification that the cut end of the strip has a skive angle. See e.g., paragraph 49. Applicant is simply conforming the drawings to the teachings of the specification.

The objection to Figure 7 is now moot in light of the cancellation of Figure 7 herewith. For the reasons cited above, it is respectfully requested that these objections be withdrawn.

35 U.S.C. 112, first paragraph

Claims 1-5, 20 and 22 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. 35 USC 112, first paragraph requires that specification teach a person skilled in the art how to make and use the claimed invention. In order to assert a *prima facie* case of lack of enablement, the Examiner must provide a rational basis as to why the specification does not enable a person skilled in the art how to make and use the invention without undue experimentation.

Claim 1 recites as follows:

1. A method of cutting a strip of elastomeric material into segments of a desired length, the strip having a width W, the strip being formed of a plurality of tire components, at least one of the tire components being a cord reinforced component, the cords being substantially parallel and oriented in the direction of a cutting path formed across the width W of the strip; the method comprising:

moving a cutting device into cutting engagement of the strip while supporting the strip on an anvil;

positioning the cutting edge of the cutting device at a skive angle less than 10 degrees relative to the strip and at a gap distance (d) above the anvil slightly less than or equal to the thickness of the cord reinforced component;

cutting through the entire strip in a single cutting step while maintaining the gap distance (d) without cutting the cords, and forming a segment.

With respect to claim 1, the office action appears to object to the gap distance (d). The Examiner does not believe a gap distance d is maintained while making the cut. Page 3, last line of paragraph 2, Examiner's Office communication of 10/01/2007. Support for this claim

limitation may be found in: paragraph 15, paragraph 43, paragraph 44, paragraph 47, original claim 6, and figures 5a-5c.

If the Examiner does not believe the gap distance (d) exists, Applicant invites the Examiner to provide contrary evidence that the claimed limitation is not taught by Applicant's specification or to provide further evidence that the claimed gap does not exist when making the cut. While it may be the case that the Examiner does not understand how or why the invention works, 35 USC 112 only requires the teachings to enable a person skilled in the art how to make and use the invention. Applicant has met this requirement. Applicant has also described how he believes the invention works in his own language, even though not required. See paragraphs 46 and 47.

The office action further objects to paragraph 17 of the specification which recites "the means for supporting the strip has two surfaces inclined at angles  $\theta_1$  and  $\theta_2$  respectively,  $\theta_1$  is preferably set about 2 degrees less than skive angle  $\alpha$ , the angle  $\theta_2$  is about 2 degrees more than the skive angle  $\alpha$ ". The office action inquires as to what the angles are measured relative to. The angles  $\theta_1$  and  $\theta_2$  are shown in Figure 5a, and are measured relative to the horizontal. As previously stated, the skive angle is also measured relative to the strip. The specification teaches that the anvil has surfaces angled at  $\theta_1$  and  $\theta_2$  forming a transition point (paragraph 47) and fixing the gap (d) at the transition point. The Examiner opines that if  $\theta_2$  is different from the skive angle  $\alpha$ , then the gap will constantly change as the blade penetrates, and that if the gap is not maintained, then there is no gap. Applicant respectfully disagrees. Applicant invites the Examiner to provide evidence of his assertions of fact.

With respect to the Figure 7 and Figure 8b comments, Applicant has canceled Figure 7 and explained the amendments to Fig 8b, above.

Based upon the foregoing, Applicant respectfully requests these rejections be withdrawn.

Claims 1-5 and 20 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully disagrees. The gap of the anvil, and the angles  $\theta_1$  and  $\theta_2$  are part of the claimed invention, and therefore should be given patentable weight. Based upon the foregoing, Applicant respectfully requests these rejections be withdrawn.

35 U.S.C. 103(a)

Claims 1-3 and 20, 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bell et al. '508 in view of Benzing II et al. '101. This rejection is respectfully traversed for the following reasons. The Bell reference teaches cutting through unreinforced rubber sheets and does not teach cutting through reinforced ply. Further, Bell does not teach nor suggest orienting his cutting element at the claimed gap distance (d), which is slightly less than or equal to the thickness of the cord reinforced component. According to Bell's specification at column 8, lines 26-36, the free end of the blade 46 is received or anchored in a pocket of a blade rest, which is received in a channel 12 of the anvil. Therefore, Bell does not teach nor describe that the cutting edge of the cutting element is set at a gap distance (d) above the anvil. The Benzing reference, which is owned by Applicant (and the inventor of this case is also a named inventor), teaches a two-step process for cutting through reinforced ply. First the blade is oriented at an angle Beta in order to position the cutting element between two parallel cords. Then the blade is oriented at angle theta in order to complete the cut. See Abstract of Benzing. While Benzing teaches cutting through reinforced ply without cutting through cord, it requires a two step process. Further, the claimed gap distance (d) is not taught. Thus, the references alone or in combination

do not teach nor suggest Applicant's claimed process. As Bell et al. '508 in view of Benzing II et al. '101 fails to establish *prima facie* obviousness of the invention as recited in claims 1-3 and 20, it is respectfully requested that this rejection be withdrawn.

Claims 4 and 5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. '508 in view of Benzing II et al. '101 and further in view of Sergel et al. '601 or Oldeman '774. This rejection is respectfully traversed for the following reasons. See the reasons, above. Further, neither the Sergel reference nor the Oldeman reference is concerned with cutting reinforced ply. As Bell et al. '508 in view of Benzing II et al. '101 and further in view of Sergel et al. '601 or Oldeman '774 fails to establish *prima facie* obviousness of the invention as recited in claims 4 and 5, it is respectfully requested that this rejection be withdrawn.

In light of this amendment, all of the claims now pending in the subject patent application are allowable. Thus, the Examiner is respectfully requested to allow all pending claims.

Respectfully submitted,

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